

Attorney Docket No.: 47237-0561-00-US (216942)

Application No.: 10/541,073

Office Action Dated: November 26, 2008

Reply Dated: May 26, 2009

REMARKS

Reexamination and reconsideration are respectfully requested in view of the foregoing amendments and following remarks. The amendments are made solely to expedite prosecution, and Applicant does not thereby concede or imply that any aspect of the grounds for any rejection are proper. The amendments thus are without disclaimer and without prejudice to Applicant's rights to pursue any canceled subject matter in this application or in a continuing application.

1. Status of the Claims

The status of the claims following entry of the amendment is as follows:

Claims canceled: Claims 1-2 and 7-28

Claims pending: Claims 3-6 and 29-33

Claims allowed: None

Claims rejected: Claims 3-6 and 29-33

Claims withdrawn: None

2. Support for the Amendments

The amendment to claim 29 incorporates the subject matter of dependent claims 30, 31, or 33. The amendments thus do not introduce impermissible new matter.

3. Notice of Prosecution in Related Applications

The Office alleges that Applications No. 10/485,456 and No. 10/529,014 are related to the present application. The following Office Actions were issued by the Examiner in Application No. 10/485,456:

- Final Rejection, mailed July 16, 2009;
- Non-Final Rejection, mailed December 9, 2008; and
- Requirement for Restriction/Election, mailed June 24, 2008.

The following Office Actions were issued by the Examiner in Application No. 10/529,014:

Attorney Docket No.: 47237-0561-00-US (216942)

Application No.: 10/541,073

Office Action Dated: November 26, 2008

Reply Dated: May 26, 2009

- Final Rejection, mailed March 2, 2009;
- Non-Final Rejection, mailed July 3, 2008; and
- Requirement for Restriction/Election, mailed March 27, 2008.

4. Request for Indication of the Status of the Figures

In the Office Action dated January 16, 2008, the Office objected to the Figures. Office Action, ¶ bridging pages 3-4. Applicants traversed the objection in their response filed July 15, 2008. The present Office Action Summary does not repeat the objection but does not indicate whether the Drawings are accepted.

Applicants thus respectfully request an indication that the Drawings are accepted.

5. Request for Indication of the Status of the Specification

In the Office Action dated January 16, 2008, the Office objected to the specification's Abstract. Applicants provided a substitute Abstract addressing the Office's concerns. Applicants respectfully request acknowledgement that the Abstract has been accepted.

6. Rejection under 35 U.S.C. § 102(e)

Claims 4 and 29 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Published Application No. 2004/0266874 A1 ("Akimoto"). The Office maintains the rejection of claims 4 and 29 as allegedly anticipated by Akimoto. In the Advisory Action, the Office mischaracterizes Applicants' response. The rejection is unsubstantiated and must be withdrawn, because the Office fails to provide adequate evidence to shoulder its burden of proving inherency beyond possibility or probability.

Solely to expedite prosecution, however, Applicants incorporate the subject matter of claims 30, 31, or 33 into claim 29. The Office acknowledges that the subject matter of claims 30, 31, or 33 is not anticipated by Akimoto. Because Akimoto does not teach each and every element of presently amended claim 29, Akimoto does not anticipate the claim. The rejection accordingly must be withdrawn for this reason, as well.

Attorney Docket No.: 47237-0561-00-US (216942)

Application No.: 10/541,073

Office Action Dated: November 26, 2008

Reply Dated: May 26, 2009

7. Rejection under 35 U.S.C. § 103(a)

Claims 3-6 and 29-32 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Akimoto in view of Strub, *Southern Med. J.* 96: 363-66 (“Strub”); and Nucleus Medical at <http://ebsco.smartimagebase.com/displaymonograph.php?MID=138> (“Nucleus Medical”).

Applicants traverse the rejection, because Akimoto is disqualified as prior art. 35 U.S.C. § 103(c) provides, *inter alia*:

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In the present case, Akimoto and the present application were commonly owned at the time of invention, for the reasons stated in Applicants’ response filed May 26, 2009.

The rejection is based on Akimoto as the primary reference in the proposed combination of Akimoto, Strub, and Nucleus Medical. The Office does not make a case that the rejection can stand on Strub and Nucleus Medical alone. Because the Office has not made a *prima facie* case of obviousness over the combination of only Strub and Nucleus Medical, the rejection is improper and should be withdrawn. Applicants request allowance of the claims.

In the Advisory Action, the Office alleges that JP 2003-369147 and PCT/JP05/16351 must be provided in the English language. The Office cites 37 C.F.R. § 1.55 and MPEP § 201.15 to support its position. Neither apply.

37 C.F.R. § 1.55(a)(4)(i)(B) (emphasis added) provides that the Office may require an English language translation of a non-English language foreign application, when “necessary to overcome the *date* of a reference relied upon by the examiner.” Similarly, MPEP § 201.15 provides (emphasis added):

the *only* times during *ex parte* prosecution that the examiner considers the merits of an applicant’s claim of priority is when a reference is found with an effective *date* between the date of the foreign filing and the date of filing in the United States and when an interference situation is under consideration.

Attorney Docket No.: 47237-0561-00-US (216942)

Application No.: 10/541,073

Office Action Dated: November 26, 2008

Reply Dated: May 26, 2009

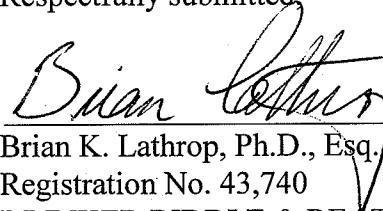
The *date* of Akimoto is not at issue in the present case. The only issue before the Office is whether Akimoto is *disqualified* as prior art under 35 U.S.C. § 103(c). Applicants present arguments that it is. The Office presents no relevant arguments to rebut Applicants' position. Because Akimoto is disqualified as prior art, the rejection must be withdrawn. This argument constitutes Applicants' request for reconsideration, under 37 C.F.R. §§ 1.181 and 1.183.

CONCLUSION

The application is believed to be in condition for allowance, and an indication of the same is respectfully requested. Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 50-0573 for any such fees; and Applicants hereby petition for any needed extension of time. If an Appeal Fee is required to maintain pendency of the present application, the Office is authorized to charge the Appeal Fee and use this paper as a Notice of Appeal.

Respectfully submitted,

Date: November 27, 2009

By: 

Brian K. Lathrop, Ph.D., Esq.

Registration No. 43,740

DRINKER BIDDLE & REATH LLP

1500 K Street, NW Suite 1100

Washington, D.C. 20005

T: (202) 842-8862

F: (202) 842-8465